

REMARKS

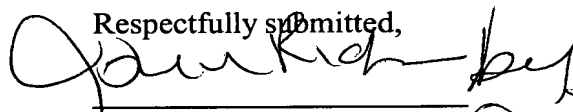

Claims 18 and 25 have been amended as suggested by the examiner to address the definition of the rings. This amendment does not effect any limitation in scope of the invention claimed and is made simply as an aid to comprehension. It is not agreed that the claims as presented previously were unclear. However, since the examiner's suggestion should simplify comprehension, it has been adopted.

Claims 18 and 25 have also been amended to delete the definition of R⁴ as trifluoromethyl. New claims 26 and 27 correspond with amended claims 18 and 25 except that they retain the definition of R⁴ as trifluoromethyl. Although in the interests of expediting prosecution the applicant has deleted trifluoromethyl from the definition of R⁴ in the previously presented independent claims, it is not agreed that such claims as previously presented add new matter. For this reason new claims 26 and 27 are presented herein. The examiner's arguments have been considered but seem to overlook the fact that the paragraph bridging pages 1 and 2 of the specification state "The present invention relates to compounds of the formula ...". On page 9 in the passage that includes reference to R⁴ as being trifluoromethyl .commences "Other more specific embodiments of the invention include ..." The "more specific" must fall within the general for what is set out in fact to be specific embodiments of the same invention as that set out on pages 1 and 2. If that which is stated to be a more specific embodiment of the general does not lie within the general statement of the invention, there is clearly an error. It is true that patent applications may contain multiple embodiments that do not necessarily fall within each other's scope. However, that is not the issue here. The issue here is the construction of the particular document filed in the present application. This specifically stated that what is set out on page 9 constitutes a specific embodiment of "the invention" and pages 1 and 2 state what "the" invention is. For consistency, it is clear that what is et out on page 9 was supposed to fall within what is set out on pages 1 and 2. The question therefore is how to interpret the true meaning of the document as filed and to simplify the task of those who later have to read it. Correction of an obvious error to achieve this objective has long been within the power of the PTO and even the courts even after the grant of a patent. *I.T.S. Rubber Co. v. Essex Rubber Co.* 272 U.S. 429 (1926). In *Superior Fireplace Co. v. Majestic Products Co.* 60 USPQ2d 1668 , the Federal Circuit pointed out that for a certificate of correction to be issued after grant the test

was whether the error was :manifest from the contents of the file of the patent sought to be corrected. As pointed out above, a mistake was clearly made in drafting the present application leading to the discrepancy between pages 1 and 2 on the one hand and page 9 on the other. It is a cardinal rule in the construction of legal documents that in cases of discrepancy between the specific and the general, the specific prevails. Where it is apparent to the reader what correction is required to accomplish the objective therefore correction of the general to bring it into conformity with the specific should be permitted. If this applies after grant, a fortiori such correction should b permitted before grant.

New claims 28 and 29 are directed to the twp specific groups of compounds set out on page 9.

In view of the foregoing, it is submitted that this application is now in order for allowance and an early action to this end is respectfully solicited.

Respectfully submitted,

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